

**REMARKS**

The Office Action mailed February 2, 2006 has been carefully considered. Within the Office Action, Claims 1-4, 9, 13, 21-24, 26-29, 45-48 and 50-74 stand rejected. Within this Reply, Claims 1, 20, 26, and 45 have been amended. Reconsideration in view of the following remarks is respectfully requested. A one month extension is included herein.

The 35 U.S.C. § 112, First Paragraph Rejection

Claims 1-4, 9, 13, 21-24, 26-29, 45-48 and 50-74 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was allegedly not described in the specification in such a way as to enable one of ordinary skill in the art to practice the invention. This rejection is respectfully traversed. Nonetheless, to expedite prosecution of the present application, Claims 1, 21, 26 and 45 have been amended to remove the phrase at issue. The Applicant respectfully request withdrawal of the rejection.

The First 35 U.S.C. § 103 Rejection

Claims 1, 2, 5, 13, 21, 25, 26, 45, 49, 51, 53-56, 58-61 and 63-74 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins<sup>1</sup> in view of '819 (Inoue et al.)<sup>2</sup>, among which claims 1, 21, 26 and 45 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

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<sup>1</sup> U.S. Patent No. 5,159,592

<sup>2</sup> U.S. Patent No. 6,891,819

or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>3</sup>

Perkins discloses that the information is sent to the global gateway, via the local gateway, by a mobile node regarding the mobile node itself. In particular, Perkins expressly states that when a mobile unit 10 enters a cell 11, it first directs a message to the local gateway 16, to send to the global gateway 18, to activate a pseudo-IP address for the mobile unit 10. The mobile unit 10 identifies itself by transmitting a unique identifier, such as its serial number, that is *permanently stored within a memory of the mobile unit 10*. (Perkins, Col 5, Lines 51-60) (emphasis added). A serial number of a mobile device does not indicate whether the particular user operating the mobile device is who he claims to be. Instead, the serial number merely identifies the device. User authentication information would be identical no matter which mobile device the user is attempting to use. In addition, Perkins discloses that the serial number is used by the global gateway to determine whether there is any data in the global node that is to be forwarded to the mobile node, and to purge saved packets, but not to authenticate the user. As such, there would be no reason for the global gateway in Perkins to receive the user's authentication information. Accordingly, the system in Perkins is not set up and provides no hint, teaching or suggestion for utilizing a user's authentication information to provide the requested information to the mobile unit.

Inoue discloses a system which allows identification of a user of a mobile unit when the mobile unit leaves a home network. As disclosed within Inoue, once the mobile unit leaves the home network, the mobile unit acquires the address to be used in the visited network. Once the

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<sup>3</sup> M.P.E.P § 2143.

address is acquired, the mobile unit transmits a registration message containing the visited network's address to the home agent. (Inoue, Col. 7, Lines 19-39). However, Inoue does not disclose that the mobile unit provides the home agent with the serial number of the mobile unit. In other words, the home agent is not able to identify the mobile unit which is contacting it. Instead, once the home agent receives the registration message from the mobile unit, the home agent blindly requests authentication information from the transmitter of the registration message (i.e. the mobile unit) in an attempt to determine whether to provide the requested information to the requester. (Inoue, Col. 8, Lines 44-49). Once the user satisfactorily answers the challenge questions, the system forwards data packets to the mobile unit.

One skilled in the art, upon viewing Perkins and Inoue would have no motivation to combine the two references in reaching the subject matter in Claims 1, 21, 26 and 45. As stated above, the mobile unit is identified in Perkins solely from the serial number permanently stored in the unit. Thus, once the gateway in Perkins receives the serial number, data packets are transferred to the mobile units. In contrast, the system in Inoue does not identify the mobile unit at all but only that the registration message is received, whereby the identity of the user is challenged thereafter by sending authentication information to the transmitter of the registration message. One skilled in the art would have no motivation to combine Perkins with Inoue, because the Perkins system would not operate properly to distinguish one user from another and would not be able to differentiate which data packets (for which user) are to be transferred to the mobile unit. In addition, the Inoue system does not utilize a HGS identifier or any method of identifying a HGS identifier, as in Claims 1, 21, 26 and 45, because the visited network information is provided to the home agent by the mobile unit itself. Accordingly, there is no motivation to one skilled in the art to use Inoue with Perkins to reach the inventions claimed in

the present application. In addition, there is no satisfactory evidence or proof that Perkins and Inoue, when combined together, would provide a reasonable amount of success. To combine the two references would require the Perkins and Inoue systems to be modified beyond what is disclosed therein and constitutes improper hindsight analysis. For at least these reasons, a prima facie case for obviousness has not been established. Accordingly, Claims 1, 21, 26 and 45 are allowable over Perkins and Inoue, individually or in combination.

As to dependent claims 2, 13, 25, 49, 51-56, 58-61 and 63-74, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

#### The Second 35 U.S.C. § 103 Rejection

Claims 3, 9, 23, 28, 47, 57 and 62 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819, in view of Holt et al.<sup>4</sup>. This rejection is respectfully traversed.

As to dependent claims 3, 9, 23, 28, 47, 57 and 62, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

#### The Third 35 U.S.C. § 103 Rejection

Claims 4, 24 and 48 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819, in view of Holt et al. as applied to the claims above

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<sup>4</sup> U.S. Patent No. 6,070,192

and further in view of Inuoe et al.<sup>5</sup>. This rejection is respectfully traversed. As to dependent claims 4, 24 and 48, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Fourth 35 U.S.C. § 103 Rejection

Claims 22, 27, 46 and 50 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins in view of '819, in view of Holt et al. as applied to the claims above and further in view of Reid et al.<sup>6</sup>. This rejection is respectfully traversed. As to dependent claims 22, 27, 46 and 50, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

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<sup>5</sup> U.S. Patent No. 6,442,616

<sup>6</sup> U.S. Patent No. 6,233,616

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

A handwritten signature in black ink, appearing to read 'S. Blat' or similar, written over a horizontal line.

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Dated: 6/1/06

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